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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/538,920

12/12/2005

Xavier Blin

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11/14/2008

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EXAMINER

HELM, CARALYNNE E

ART UNIT

PAPER NUMBER

1615

NOTIFICATION DATE

DELIVERY MODE

11/14/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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| | | | |
|------------------------------|--------------------------------------|------------------------------------|--|
| Office Action Summary | Application No. 10/538,920 | Applicant(s) BLIN ET AL. | |
| | Examiner CARALYNNE HELM | Art Unit 1615 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 55-150 is/are pending in the application.
- 4a) Of the above claim(s) 58,61-63,67,74-86,90-93,96,99-106,110 and 122-150 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 55-57,59,60,64-66,68-73,87-89,94,95,97,98,107-109 and 111-121 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Election/Restrictions***

Applicant's election with traverse of Group I and the species where Nylon 611/dimethicone copolymer is the polymer, isononyl isononanoate is the ester oil, solid particles are present and silicone oil, nonvolatile oil, and non-silicone oil are absent, in the reply filed on September 12, 2008 is acknowledged. The traversal is on the grounds that no adequate reason was provided to support a conclusion of patentable distinctness between identified groups. This is not found persuasive because the issues of patentable distinction and, more importantly, lack of unity were addressed. The technical feature that links the inventions is a composition with an ester oil and polymer has a weight-average molecular mass of from 500 to 500,000 and contains (i) at least one polyorganosiloxane group comprising from 1 to 1,000 polymerized organosiloxane monomer units, wherein the polyorganosiloxane group is present in at least one of the chain of the polymer and grafted to the polymer, and (ii) at least two hydrogen bonding groups selected from the group consisting of an ester, an amide, a sulphonamide, a carbamate, a thiocarbamate, a urea, a urethane, a thiourea, an oxamido group, a guanidine group, a biguanidino group, and combinations thereof; and the polymer is solid at room temperature and soluble in the liquid fatty phase at a temperature of from 25 to 250°C. As discussed in the restriction requirement, this technical feature was known in the art; therefore the inventions lack unity. Furthermore, a discussion of the enormous breadth of polymers claimed and the burden presented by

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having to search the collection of compositions formed by each of their combination with any of hundreds of ester oils was provided. This together with the lack of unity in the claimed inventions is sufficient to support the restriction requirement.

The requirement is still deemed proper and is therefore made FINAL.

Claims 58, 61-63, 67, 74-86, 90-93, 96, 99-106, 110, and 122-150 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions and species, there being no allowable generic or linking claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

The four factual inquiries of *Graham v. John Deere Co.* have been fully considered and

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analyzed in the rejections that follow.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 55-57, 59-60, 64-66, 68-73, 87-89, 94-95, 97-98, 107-109, and 111-121 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy (WO 01/97758 – see IDS) in view of Grimm et al. (US PGPub No. 2002/0034480), Barr et al. (US Patent No. 6,051, 216 – see IDS), and Cai et al. (US Patent No. 6,451,295).

Murphy et al. teach a translucent lip-gloss composition that includes, a polyamide resin polymer, castor oil as an emollient/solvent, coloring agent, and various other surfactants, gelling agents, emulsifiers, and non-oil emollients (see examples 1-5; instant claims 55 and 113). Murphy et al. go on to teach the formulation of their invention in lipstick (self-supported) form (see page 4 lines 27-29; instant claims 114 and 118-121). The polyamide is taught to confer solid structure to the product upon cooling, to give a translucent or transparent appearance, and be present in the formulation at 7% (see page 6 lines 21-22 and example 1; instant claims 55 and 107-

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109). In addition, the polyamide resin is taught to be soluble in a cosmetically acceptable solvent between 50°C and 150°C (see page 7 lines 5-7; instant claim 55). The envisioned solvents include castor oil as well as fatty acid esters and is exemplified at 18% of the composition (see page 10 lines 4-17 and example 1). In view of this teaching, it would have been obvious to one of ordinary skill in the art at the time of the invention to use a fatty acid ester in place of the castor oil in the composition. Since the components in example 1 of Murphy et al., with the exception of the two surfactants, preservative and dye, are organic, and absent evidence to the contrary, they are interpreted to constitute a liquid fatty phase. Therefore the fatty acid ester would constitute approximately 19% of the fatty phase and the fatty phase itself would constitute approximately 94% of the composition (instant claims 69-72 and 11-112). Murphy et al. also teach the presence of color components, including titanium dioxide, zinc oxide, iron oxides and other pigments (see page 19 lines 23-31; instant claims 87-88). It therefore would have been obvious to one of ordinary skill in the art at the time of the invention to use one of these pigments instead of or in conjunction with the dye used in the composition of example 1. Murphy et al. do not teach that the fatty acid ester is isononyl isononanoate or that the polyamide is Nylon 611/dimethicone.

Grimm et al. teach cosmetic compositions that include lipsticks (see paragraph 1). In addition, Grimm et al. teach a set of oils that are known for equivalent use in such compositions. Specifically, Grimm et al. teach both castor oil and isononyl isononanoate in this set (see paragraph 151; instant claims 56-57, 59-60, and 64-66). Since castor oil and isononyl isononanoate were known as functional equivalents in cosmetics and the

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isononyl isononanoate is a fatty acid ester, it would have been obvious to one of ordinary skill in the art at the time of the invention to use isononyl isononanoate instead of castor oil in the invention of Murphy et al. (e.g. example 1).

Barr et al. and Cai et al. teach the same set of siloxane based polyamide polymers for conferring structure/thickening and translucent/transparent appearance to cosmetic compositions that are also able to form gels or self-supported sticks (see Barr et al. abstract, column 1 lines 19-20, 33-37 and 59-67, column 4 lines 21-23, and formula A, Cai et al. column 1 lines 33-67 and Formula IIIA; instant claims 89, 94-95, and 97-98). In addition to a genus of compounds, Cai et al. teach the polyamide Nylon 611/dimethicone as one particularly envisioned embodiment in this polymer set (see column 15 lines 22-26; instant claims 89, 94-95, and 97-98). Since this particular polyamide was known at the time of the invention for its thickening abilities as well as suitability for translucent/transparent cosmetic formulations, it would have been obvious to one of ordinary skill in the art to use it as the polyamide in the composition of Murphy et al. in view of Grimm et al. The result would be a transparent/translucent cosmetic composition with isononyl isononanoate, Nylon 611/dimethicone and solid pigment particles. Optimization of the amounts of these ingredients to confer particular desired properties for the end product (e.g. lip-gloss vs. lipstick, different colors, etc.) would have been a matter of routine experimentation for one of ordinary skill. Therefore claims 55-57, 59-60, 64-66, 68-73, 87-89, 94-95, 97-98, 107-109, and 111-121 are obvious over Murphy et al. in view of Grimm et al., Barr et al., and Cai et al.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 55-57, 59-60, 64-66, 68-73, 87-89, 94-95, 97-98, 107-109, and 111-121 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13, 19, 39-45, 47-48, and 54-55 of U.S. Patent No. 7,078,026 in view of Vatter et al. (US Patent No. 6,224,888). Both the instant and the conflicting claims of patent 7,078,026 teach a transparent composition with the same polymer gelling agent (siloxane based polyamide) and solid particles. The claims of patent 7,078,026 require a silicone oil while, those of the instant application require an ester oil. Vatter et al. teach that isononyl isononanoate, an ester oil, and silicone oil are both known to be non-polar emollients used in cosmetics (see column 5 lines 27 and 36, and column 6 lines 10-13). Since this ester oil and silicone oil are known to be

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functional equivalents in cosmetic compositions, it would have been obvious to one of ordinary skill in the art at the time of the invention to use isononyl isononanoate instead of the silicone oil in the composition of patent 7,078,026. Therefore claims 55-57, 59-60, 64-66, 68-73, 87-89, 94-95, 97-98, 107-109, and 111-121 are obvious over 1-13, 19, 39-45, 47-48, 54-55 of U.S. Patent No. 7,078,026 in view of Vatter et al.

Claims 55-57, 59-60, 64-66, 87-89, 94-95, 97-98, 111-115, and 118-121 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2, 9-14, 17, 30, 62, and 64-67 of copending Application No. 10/517390 and claims 1, 4, 10, 17, 54, 56, and 66 of copending application 11/898093 each in view of Vatter et al. separately. Both the instant and the conflicting claims of each copending application teach a transparent composition with the same polymer gelling agent (siloxane based polyamide) and solid particles. The claims of copending applications require a silicone oil while, those of the instant application require an ester oil. Vatter et al. teach that isononyl isononanoate, an ester oil, and silicone oil are both known to be non-polar emollients used in cosmetics (see column 5 lines 27 and 36, and column 6 lines 10-13). Since this ester oil and silicone oil are known to be functional equivalents in cosmetic compositions, it would have been obvious to one of ordinary skill in the art at the time of the invention to use isononyl isononanoate instead of the silicone oil in the composition of copending applications. Therefore instant claims 55-57, 59-60, 64-66, 68-73, 87-89, 94-95, 97-98, 111-115, and 118-121 are obvious over claims 1-2, 9-14, 17, 30, 62, and 64-67 of copending

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Application No. 10/517390 and claims 1, 4, 10, 17, 54, 56, and 66 of copending application 11/898093 each in view of Vatter et al. separately.

This is a provisional obviousness-type double patenting rejection.

Claims 55-57, 59-60, 64-66, 87-89, 94-95, 97-98, 107-109, 113, and 115 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, 12, 15, 26-28, and 50 of copending Application No. 10/538924, in view of Vatter et al. Both the instant and the conflicting claims of copending application 10/538924 teach a transparent composition with the same polymer gelling agent (siloxane based polyamide) and solid particles. The claims of copending application 10/538924 require a silicone oil while, those of the instant application require an ester oil. Vatter et al. teach that isononyl isononanoate, an ester oil, and silicone oil are both known to be non-polar emollients used in cosmetics (see column 5 lines 27 and 36, and column 6 lines 10-13). Since this ester oil and silicone oil are known to be functional equivalents in cosmetic compositions, it would have been obvious to one of ordinary skill in the art at the time of the invention to use isononyl isononanoate instead of the silicone oil in the composition of copending application 10/538924. Therefore instant claims 55-57, 59-60, 64-66, 87-89, 94-95, 97-98, 107-109, 113, and 115, and 118-121 are obvious over claims 1, 3, 12, 15, 26-28, and 50 of copending Application No. 10/538924 in view of Vatter et al.

This is a provisional obviousness-type double patenting rejection.

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Claims 55-57, 59-60, 64-66, 87-89, 94-95, 97-98, 107-109, 113-115, and 118-121 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 4-5, 18, and 25-28 of copending Application No. 11/342748 in view of Vatter et al. Both the instant and the conflicting claims of copending application 11/342748 teach a transparent composition with the same polymer gelling agent (siloxane based polyamide) and solid particles. The claims of copending application 11/342748 require a silicone oil while, those of the instant application require an ester oil. Vatter et al. teach that isononyl isononanoate, an ester oil, and silicone oil are both known to be non-polar emollients used in cosmetics (see column 5 lines 27 and 36, and column 6 lines 10-13). Since this ester oil and silicone oil are known to be functional equivalents in cosmetic compositions, it would have been obvious to one of ordinary skill in the art at the time of the invention to use isononyl isononanoate instead of the silicone oil in the composition of copending application 11/342748. Therefore instant claims 55-57, 59-60, 64-66, 87-89, 94-95, 97-98, 107-109, 113-115, and 118-121 are obvious over claims 1, 4-5, 18, and 25-28 of copending Application No. 11/342748 in view of Vatter et al.

This is a provisional obviousness-type double patenting rejection.

Conclusion

No claim is allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARALYNNE HELM whose telephone number is (571)270-3506. The examiner can normally be reached on Monday through Thursday 8-5 (EDT).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward or Tracy Vivlemore can be reached 571-272-8373 and 571-272-2914, respectively. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Caralynne Helm/
Examiner, Art Unit 1615

/Tracy Vivlemore/
Primary Examiner, Art Unit 1635